

REMARKS

Claims 20 to 26 and 29 to 39 are pending and being considered in the present application, since claims 1 to 19 were previously withdrawn in response to a restriction response.

It is respectfully submitted that all of the presently pending and considered claims are allowable, and reconsideration is therefore respectfully requested.

It is believed that this Amendment does not raise new issues that would require further consideration and/or search, and also does not raise the issue of new matter. It is also believed and respectfully submitted that this Amendment places the application in better form for appeal by materially reducing or simplifying the issues for appeal.

With respect to paragraph one (1) of the Office Action, Claim 32 was objected to as depending from canceled claim 27. Accordingly, claim 32 now depends from claim 20. Approval and entry are respectfully requested, as is withdrawal of the objection.

With respect to paragraph three (3), claims 20 to 26 and 29 to 39 were rejected under 35 U.S.C. § 103(a) as unpatentable over United States Patent No. 6,493,629 to Van Bosch (the "Van Bosch" reference) in view of United States Patent Publication No. 2002/0156558 to Hanson et al. (the "Hanson" reference) and further in view of United States Patent No. 6,295,492 to Lang et al. (the "Lang" reference). Applicants respectfully submit that claims 20 to 26 and 29 to 39 are allowable for at least the following reasons.

It is respectfully submitted that the combination of the references does not render obvious the subject matter of claims 20 to 26 and 29 to 39. The Office Action admits that the "Van Bosch" reference does not disclose a sensor for transmitting error code that concerns diagnostic information, nor a sensor that is coupled to the controller by a vehicle bus. (Office Action; page 2, ll. 2-4). The Office Action asserts that these features are taught by the "Hanson" and "Lang" references. The combination of the references, even including the "Hanson" reference (which may not be prior art) does not render obvious the subject matter of claim 20.

Claim 20 is directed to a system for monitoring at least one apparatus in a vehicle including: at least one sensor situated in the vehicle for sensing at least one error code of the at least one apparatus, the at least one sensor being electrically coupled to a vehicle bus; a gateway node situated in the vehicle, the gateway node being electrically coupled to the

vehicle bus, the at least one sensor for communicating the at least one error code to the gateway node via the vehicle bus using a network protocol, the gateway node including a controller arrangement and a first wireless protocol arrangement, the first wireless protocol arrangement being coupled to the controller arrangement; and a processor, the gateway node communicating the at least one error code to the processor via a second wireless protocol arrangement that communicates with the first wireless protocol arrangement, using a wireless communication protocol, in which the at least one error code concerns diagnostics information and is accessible from the vehicle bus.

As explained in the present application, this system provides the benefit of providing for a remote diagnostics system that obtains information from the vehicle bus:

In another embodiment, the sensor data is used in a diagnostic procedure to evaluate the vehicle systems. Sensor 11 may therefore also be any type of sensor evaluating another vehicle system or, alternatively, any system with self-diagnosing capabilities (i.e. any system capable of evaluating its own status). . . .

The status of sensor 11 might be communicated to the vehicle bus 12, where the controller 13 could read the status off the bus and communicate it to Bluetooth hardware 14 (or any other appropriate short-range wireless transmitter). Bluetooth hardware 14 might transmit the status code to remote Bluetooth hardware set 16 (or another short-range wireless transmitter). Remote Bluetooth hardware set might communicate the status code to processor 17, which might be a handheld computer running a diagnostic program. . . .

(Specification, pages 8 and 9).

The “Van Bosch” reference does not disclose or suggest, in the context of the claimed subject matter of claim 20, a gateway node to which the at least one sensor communicates at least one error code via the vehicle bus using a network protocol. The Office Action apparently relies on all three references, the “Van Bosch”, the “Hanson”, and the “Lang” references in asserting that the combination of the references renders the subject matter of this claim obvious. (Office Action; page 2, ll. 8-12). However, the Office Action identifies various discrete elements of claim 20 and suggests their combination without providing a motivation for the combination. Additionally, none of the references discloses a gateway node that is electrically coupled to a vehicle bus in which a sensor communicates an error

code to the gateway node via the vehicle bus. It is therefore respectfully requested that the obviousness rejection of claim 20 be withdrawn.

As further regards the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). It is respectfully submitted that the references, even if combined, would not solve the problems met by the presently claimed subject matter, as referred to herein.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), refer to when an Office Action’s assertions that it would have been obvious to modify the reference relied upon will not properly support a 35 U.S.C. § 103 rejection. It is respectfully suggested that those cases make plain that if the Office Action reflects a subjective “obvious to try” standard, it does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to

make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). More recently still, in the case of In re Lee, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could

not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

In its decision on Lee's patent application, the Board rejected the need for “any specific hint or suggestion in a particular reference” to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

[The] “common knowledge and common sense” on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation.

[The] Board's findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

Accordingly, and in view of the foregoing, it is respectfully submitted that the Office Action's unsupported assertion that it would have been obvious to replace the sensors 120 (fig. 2) of “Hanson” with the sensors of “Lang” and to connect the sensor to the system bus of Bosch in order to provide diagnostic information of the vehicle subsystems to the wireless device 130 (fig. 2) does not provide sufficient motivation to support the combination. The only motivation to combine the references comes from the disclosure of the present application, which constitutes improper hindsight reasoning. Since there is no motivation or suggestion to combine the references, the references do not render the subject matter of claim 20 obvious.

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It is therefore respectfully submitted that claim 20 is allowable, as are its dependent claims 21 to 26 and 29 to 32.

Claim 33 includes features like those of claim 20, and is therefore allowable for essentially the same reasons as claim 20. Claims 34 to 39 depend from claim 33 and are therefore allowable for the same reasons as claim 33.

CONCLUSION

In view of the above, it is believed that the objection and the rejections have been obviated, and it is therefore respectfully submitted that claims 20 to 26 and 29 to 39 are allowable. It is therefore respectfully requested that the objection and rejections be reconsidered and withdrawn, and that the present application issue as early as possible.


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Respectfully submitted,

By: 

Richard L. Mayer
(Reg. No. 22,490)

KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646


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